

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CHRISTINE ANN MUELLER

Appeal No. 2006-0301
Application No. 09/837,932

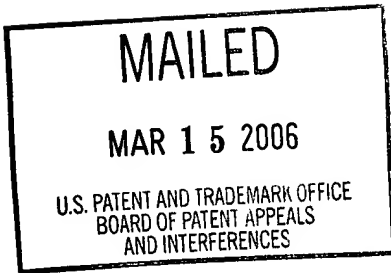
HEARD: FEBRUARY 22, 2006

Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3-14 and 16-18, which are all of the claims pending in this application.

We AFFIRM-IN-PART.



BACKGROUND

The appellant's invention relates to a lighting system for use within a frame member for lighting of transparent or translucent surfaces. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The Applied Prior Art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Torrence	4,922,384	May 1, 1990
Schöniger et al (Schöniger)	5,027,258	Jun. 25, 1991

The Rejection

Claims 1, 3-14 and 16-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schöniger in view of Torrence.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (mailed August 3, 2005) for the examiner's complete reasoning in support of the rejections and to the brief (filed November 12, 2003) and reply brief (filed April 8, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Initially, we observe that appellant has elected not to argue claims 3-6, 8, 10-14 and 16-18 apart from claim 1. Thus, in accordance with 37 CFR § 1.197(c)(7) in effect at the time appellant's brief was filed, this panel is free to select claim 18 as the representative claim on which to decide the appeal of the rejection of these claims, with claims 1, 3-6, 8, 10-14, 16 and 17 standing or falling therewith.

Appellant argues on pages 3-5 of the brief and on pages 1-3 of the reply brief that Schöniger does not disclose the electrical light source emitter, when emitting light, substantially contacting the eroded transparent or translucent glass member. Initially, we note that representative claim 18 contains no such limitation. It is well established that limitations not appearing in the claims cannot be relied upon for patentability. In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). Moreover, we note that Schöniger does disclose, in Figure 4, substantial contact of the LED 15 with the light guide panel 10.

While we consider the showing in Schöniger's Figure 4 to be unambiguous with respect to contact between the LED 15 and the light guide panel 10, we also note that Schöniger also discloses, in column 2, lines 31-37, that

the light guide batten may also be in the form of essentially two strip-like batten elements respectively arranged laterally on one edge zone of the light guide panel and which may end flush with the light guide panel or may project past its edge zone. The holes for receiving the LED's may then extend into the light guide panel.

Further, in column 6, lines 24-26, Schöniger discloses that "in the fourth working example as shown in FIG. 4, the blind hole 14 extends into the batten elements 21 and the light guide panel 10." These two statements by Schöniger reinforce to one of ordinary skill in the art that there is substantial contact between the LEDs 15 and the light guide panel 10.

In light of the above, appellant's argument with respect to the lack of any showing of substantial contact between the LEDs 15 and light panel 10 of Schöniger is not well taken, even when considered with respect to claim 1, the only independent claim that includes a limitation that the electrical light source emitter, when emitting light, substantially contacts the eroded transparent or translucent glass member.

Appellant also argues that Schöniger does not disclose that the contrast panel 19, on which the examiner reads the opaque glass backing member of claim 18, is reflective. While this is true, the examiner also found this to be the case and determined that it would have been obvious, in view of the teachings of Torrence, to

make the contrast panel 19 reflective and appellant has not specifically challenged that determination. Rather, appellant argues that, because Torrence does not disclose an electrical light source emitter, when emitting light, substantially contacting the eroded transparent or translucent glass member, Torrence teaches away from the combination of the Schöniger and Torrence patents. This argument is not at all well taken.

First, we note that Torrence is not relied upon for a teaching of contact between the light source and the transparent or translucent glass member and that nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Further, as to the specific question of "teaching away," a reference may be said to teach away when a person of ordinary skill, upon examining the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. See In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). In this instance, we see nothing in Torrence's lack of disclosure of contact between the light source and the transparent or translucent glass member which would have discouraged a person of ordinary skill in the art from using a reflective opaque member as the contrast panel 19 of Schöniger.

For the reasons stated above, appellant's arguments in the brief and reply brief fail to persuade us of any error on the part of the examiner in rejecting representative

claim 18, or claim 1, the only independent claim which recites the limitation on which appellant's arguments are centered, as being unpatentable over Schöniger in view of Torrence. The examiner's rejection of representative claim 18, as well as claims 1, 3-6, 8, 10-14, 16 and 17 which stand or fall therewith, is thus sustained.

The appellant's additional argument with respect to claim 7 is that there is no teaching in Schöniger or Torrence that the reflective opaque glass backing member is at least partially painted. This argument is not commensurate with the scope of claim 7, which simply requires that at least one of said eroded transparent glass member, said eroded translucent glass member or said reflective opaque glass backing member is at least partially painted.¹ With regard to this limitation, the examiner points out on page 4 of the answer that the logo symbols 13, which are applied to the light guide panel 10, may be in the form of vapor coatings (Schöniger, column 4, line 30) and appellant does not dispute that this would meet the claim limitation. Accordingly, the rejection of claim 7 is also sustained.

We shall not, however, sustain the rejection of claim 9. Neither Schöniger nor Torrence discloses a rope light, which one of ordinary skill in the art would understand to comprise tubing having spaced bulbs disposed therein.

¹ As pointed out on page 5 of the answer, the examiner denied entry of the amendment to claim 7 filed concurrently with the brief.

To summarize, the decision of the examiner to reject claims 1, 3-14 and 16-18 under 35 U.S.C. § 103 is affirmed as to claims 1, 3-8, 10-14 and 16-18 and reversed as to claim 9. The examiner's decision is AFFIRMED-IN-PART.

AFFIRMED-IN-PART

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